Appl. No. 10/696,295
Amdt. dated: February 4, 2005
Reply to Office Action of January 25, 2005

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-29 are pending in the current application, each of which stand rejected by the Office Action mailed August 18, 2004. By the instant amendment, independent claims 1, 11, 16 and 24 have been amended and new claim 29 added. In response to the Office Action mailed January 25, 2005, proper parenthetical status identifiers have been used in the listing of the claims. No new matter has been added by these amendments. Favorable reconsideration of the application is respectfully requested in light of the foregoing amendments and following remarks.

II. Rejections Under 35 U.S.C. §101

Claims 1-6, 11-14, 16, 22-23 and 25-26 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In this regard, the office action states that these claims are not limited by language within the technological arts.

Although Applicants respectfully traverse the rejection, as described below, in an effort to advance prosecution, Applicants have amended independent claims 1, 11, 16 and 24 to recite computer hardware and computer code. More specifically, claim 1 is now directed to a method of providing an add "via a computer network", which utilizes an integrated ad file "containing computer code for providing the ad." The method also includes serving the integrated ad file "containing computer code for providing the ad." The method also includes serving the integrated ad file "from a computer to provide the ad." Applicants respectfully submit that claim 1, as originally drafted, already included language within the technical art, namely "serving the

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integrated ad file". As such, the claim already included computer limitations and, as such the

present amendments are not believed to be narrowing. Similarly, claims 11 and 16 also specify

"the ad file include[s] computer code for providing the ad." Claims 11 and 16 further recite that

they are directed to a method of facilitating providing an ad "by loading an ad file" and

electronically inserting one file into another, both of which relate to computer technology.

Accordingly, Applicants respectfully submit that each of the independent claims is

directed to the technological arts, and requests that the rejections under §101 be withdrawn.

III.   Rejections Under 35 U.S.C. §103

Claims 1-37 rejection under 35 U.S.C. §103 is being unpatentable over U.S. published

patent application 2003/0208560 to Inoue ("Inoue"). As described in greater detail below,

Applicants respectfully submit that Inoue fails to teach or suggest, either explicitly or implicitly,

the claimed invention.

In general, the application describes embodiments directed to an improved method and

system for providing an ad via the Internet or other network. As described in the present

application at paragraphs 6-8, an ad served via the Internet is typically an item of computer code

that is pulled from a server and incorporated into a Web page. The ad includes not only content,

such as text, images, audio/video, etc., but also code for tracking the effectiveness of or user

interaction with the ad. Such tracking of an ad may include tracking the number of times the ad

is viewed by users, the number of times a user activates the link in the ad or the number of times

the user makes a purchase after activating a link in the ad. To create the ad file, the entity

providing the ad generally received advertising content from advertisers or ad agencies it must

incorporate the content into the computer code of the ad file. Such process is labor intensive.

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The invention, as defined by claim 1, comprises combining two separate files—

one identifying at least content of the ad and another identifying at least tracking data—into a

single integrated ad file. The integrated ad file is served, for example from an ad server for

display to a user viewing a Web page. In this regard, claim 1 recites:

> combining an ad input file with a conduit file to create an
> integrated ad file containing computer code for providing the ad,
> wherein the ad input file identifies the content of the ad and the
> conduit file identifies tracking data for the ad; and

> serving the integrated ad file from a computer to provide
> the ad.

Each of the other independent claims similarly recites combining at least two separate

files into a single file that is used to provide the ad. In this regard, claim 11 recites a first and

second file and "electronically inserting the second file into [a] placeholder [in the first file] to

create the ad file, the ad file including computer code for providing the ad."

Claim 16 recites a first, second and third file, wherein the third file includes first and

second placeholders, and "electronically inserting the first file into the first placeholder and

electronically inserting the second file into the second placeholder to create the ad file, the ad file

including computer code for providing the ad." Similarly, claim 24 recites "electronically

inserting the second file into the placeholder to create an integrated ad file, the integrated ad file

containing computer code for providing the ad."

Thus, in each of the independent claims, at least two files are combined to create an

integrated ad file. The integrated ad file contains computer code for providing the ad.

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As admitted in the Office Action, Inoue lacks disclosure of combining two files to create

an integrated ad file. Office Action at page 5. However, the Office Action states that Inoue

implicitly teaches such limitation. Applicants respectfully traverse the rejection.

In arguing that Inoue implicitly teaches the claimed invention, the Office Action simply

points to several figures and numerous paragraphs and states that the claimed limitation of

"combining an ad input file with a conduit file to create an integrated ad file" implicitly shown

because:

> modification and interpretation of the cited disclosure of Inoue
> would have provided "an advertisement distribution system which
> selects only useful advertisements corresponding to store attributes
> of a target store and transmits the selected advertisements to the
> store . . . ." (see Inoue (para. 8)) based on the motivation to modify
> Inoue so as to "[select] advertisement contents which are suitable
> or ad-user attributes, and for distributing the advertisement
> contents data and its corresponding advertisement attribute
> information through a computer communications network." (See
> Inoue (the Abstract)). Office Action pp. 5-6.

Applicants respectfully submit that the argument fails to establish a prima facie case of

obviousness and that Inoue fails to render the claimed invention obvious. First, the Office

Action fails to address the entire limitation, namely that particular types of files—an ad input file

identifying content and a conduit file that identifies tracking data—are combined into the

integrated ad file. As described in detail below, the cited paragraphs of Inoue fail to teach or

suggest any of the input file, conduit file or integrated ad file. Second, the supposed motivation

of selecting a useful or "targeted" advertisement is irrelevant to the claimed invention and cannot

provided the necessary motivation.

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The Office Action cites to numerous paragraphs of Inoue, without explanation, in support

of disclosing the limitation of combing files to create the integrated ad file, as claimed. However,

none of the cited sections teaches or suggests "combining an ad input file with a conduit file to

create an integrated ad file containing computer code for providing the ad, wherein the ad input

file identifies the content of the ad and the conduit file identifies tracking data for the ad; and

serving the integrated ad file from a computer to provide the ad." Claim 1. The Office Action

provides no correspondence between the described aspects of Inoue and the elements of the

claims, and none exists.

Indeed, the cited paragraphs simply discuss various electronic records, having various

fields of information. None of the records is an "integrated ad file containing computer code for

providing the ad" that is created by combining an ad input file identifying content and a conduit

file that identifies tracking data. An electronic file containing mere data, as described in Inoue,

is not computer code. Moreover, the advertisement in Inoue that is printed by the ECR is

preexisting in the "advertisement content storage unit", so no combining of files to create an

integrate ad file is suggested. Inoue paras. 12, 18. Furthermore, Inoue fails to include [code for]

tracking data in the file that is used to provide the ad as recited in claim 1. As described in

embodiments of the present application, tracking the ad involves monitoring the effectiveness of

or user interaction with the ad, such as the number of time the user activates a link in the ad and

makes a purchase (an "acquisition") or simply activates the link in the ad (a "click-through").

See, e.g., Application paras. 6, 34.

With regard to independent claim 11, Inoue fails to teach or suggest "electronically

inserting the second file into the placeholder to create the ad file, the ad file including computer

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code for providing the ad"; and with regard to independent claim 16, Inoue fails to teach or

suggest "electronically inserting the first file into the first placeholder and electronically inserting

the second file into the second placeholder to create the ad file, the ad file including computer

code for providing the ad"; and with regard to independent claim 24, Inoue fails to teach or

suggest "electronically inserting the second file into the placeholder to create an the integrated ad

file, the integrated ad file containing computer code for providing the ad."

Although it is unclear what claim element each paragraph of Inoue is relied on as

teaching, the cited paragraphs of Inoue will now be addressed in greater detail. Several of the

cited paragraphs relate to the Master File M1. The Master File is a database record that includes

fields of information regarding the advertiser, such as ID and name, a URL of the advertisement

content, advertisement-providing conditions, such as targeted age and sex of the customer, and

usage data, such as number of times the advertisement is printed. See, e.g., Inoue paras. 79-83.

No files are combined, as is recited in the claims, to create the Master File M1.

Other cited paragraphs relate to the Store Master File M2. However, this database record

simply contains store attributes "given by newly-registered store[s]" that desire to receive and

print the advertisements to be provided to customers. See, e.g., Inoue paras. 86, 88.

The Office Action also cites to the Advertisement file F1. The Advertisement File F1 is

yet another database record. As shown and described with reference to Fig. 5A, each database

record contains Store ID and Advertisement ID. While the Store ID also exists in the Store

Master File M2, and the Advertisement ID also exists in the Master File M1, there is no

suggestion to combine files, let alone into an integrated ad file containing computer code that is

served. As explicitly described in Inoue, the Store ID and Advertisement ID are simply "data items"—fields in a database record. See, e.g., Inoue para. 93.

The transmission data file F2 is also cited. This file F2 is transmitted to the ECR and contains a URL to the actual advertisement to be printed on the customer receipt. The file F2 contains "data items", such as time, sex and age codes, for identifying to which stores the advertisement should be transmitted. In other words, these fields of data are used for selecting the useful or appropriate advertisement; they have no relation to tracking the advertisement, as called for by the conduit file recited in the claims, and is not combined with another file to create an integrated ad file.

As an additional grounds for traversing the rejection, Applicants respectfully submit that no motivation exists for arriving at the claimed invention. As noted above, the teaching relied upon in the Office Action—selecting useful or suitable advertisements—is completely unrelated to the claimed invention. While Inoue is directed to selecting appropriate advertisements, the claimed invention is directed to the creation of an integrated advertisement file; selection is not creation. The claimed invention is directed to solving a completely different problem than how to select useful or appropriate advertisements. As described in the instant specification:

> [0008] ... In general, the entity serving the ads receives the advertising content from the advertisers or agencies and must incorporate the content into the ad code. Such a process is labor intensive and requires the ad-serving entity to maintain a staff of programmers. These programmers must be used not only to incorporate the received ad content into the ad code to be served, but also to effectuate changes to the ad content received from the advertiser or agency. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

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[0042] Those skilled in the art will appreciate that the present embodiment need only load a single file—the integrated ad file 204—when serving the ad. The integration of the ad input file 504 and the conduit file 506 prior to serving the ad permits this efficiency. An alternative is loading a first ad file (for example, one file containing the content of the ad), which, in turn, loads a second ad file (for example, one file containing the tracking information). Such alternative has the disadvantages of utilizing additional bandwidth of the ad server (i.e., loading of the single integrated ad file verses loading two separate files) and the potential for failure of the second ad file to load properly. Indeed, with a portal or other provider serving numerous ads, these disadvantages make the alternative of serving two separate files commercially unworkable.

Because the present invention is directed to more efficiently creating or providing advertisements, and not to providing targeted advertisements, the present invention is applicable to either targeted or generic advertisements; the selection of useful advertisements of Inoue is irrelevant.

Accordingly, Applicants respectfully submit that Inoue fails to render obvious, either explicitly or implicitly, the claimed invention and that the claims are in condition for allowance. In this regard, Inoue fails to teach or suggest the claimed limitations and to provide any motivation for arriving at them.

The Dependent Claims are further Distinguishable over the Art of Record

Applicants further submit that the dependent claims are further distinguishable from Inoue. In rejecting the dependent claims, the Office Action states that the details of the dependent claims are implicitly shown in Inoue, citing the same motivation as noted above in connection with the independent claims. The Office Action further takes Official Notice that the concept and advantages of the elements and limitations of the dependent claims were well known

and expected in the art at the time of the invention. Office Action pp. 6, 8, 9, 11. Applicants

respectfully traverse the rejections.

As an initial matter, the Official Notice is without merit, and Applicants respectfully

request the Examiner provide support for such assumptions. No art of record addresses the

problems solved by the present invention and no art of record teaches or suggests the benefits of

"combining an ad input file with a conduit file to create an integrated ad file containing computer

code for providing the ad, wherein the ad input file identifies the content of the ad and the

conduit file identifies tracking data for the ad; and serving the integrated ad file from a computer

to provide the ad." More specifically, Inoue fails to address the particular details of creating an

integrated ad file as recited in the dependent claims.

For example, Claims 2, 3, 13, 14, 22, 23 and 28 are directed to making modifications to

either of the files that are combined into the integrated ad file, thereby allowing either changes to

the content of the ad or changes to the tracking code for the ad. As described in the present

application, combining the separate files into a single integrated ad file allows freedom in

modifying either the content or the tracking code of the ad by the various entities involved in the

advertising process, without affecting the other..

> [0025] ... More specifically, because the ad content is merged
> with the code necessary for tracking the ad, as described below, the
> advertiser 110 may provide the content to many different portals
> without concerning itself with the difference in portal tracking
> methodologies. Similarly, portals may select a tracking
> methodology and implement it independently from the ad content.
> On one hand, advertisers may modify the ad content without
> implicating changes to the tracking code, and on the other hand,
> portals may modify the tracking methodology and code without
> implicating changes to the ad content.

Nothing in Inoue provides for the modification of content or tracking data in an integrated ad file, as recited in the claims. Indeed, the ability to modify either the content or the tracking code separately, without affecting the other, is unrelated to the focus and motivation of Inoue, as cited in the Office Action, namely the selection of targeted or useful ads.

Furthermore, several of the pending dependent claims are directed to specific implementations of combining multiple files into a single integrated ad file. In this regard Claims 11, 15-17, 24 and 27 recite that a particular file has a "placeholder" into which another file is electronically inserted. Such placeholder may include, by way of example, a movie clip or a "load movie" call. There is no teaching or suggestion in Inoue relating to a placeholder in a file for creating an integrated ad file. The records containing data items described in Inoue have nothing analogous to the placeholders recited in the claims.

Furthermore, certain of the claims recite particular implementation technology for combining multiple files into a single integrated ad file. In this regard, Claims 4-6 and 26 recite using Flash or a "movie clip" in order to perpetuate the combining of files. Again, nothing in the records described in Inoue is even analogous to the use of Flash, movie clip or a load movie call.

Furthermore, Claims 7-9, 18 and 19 recite the use of particular html code for providing the ad. Inoue fails to teach or suggest the use of such html or analogous code for providing ads. It is not surprising that Inoue has no reference to such code because the advertisements in Inoue are provided in a very different, non-analogous medium; whereas embodiments of the present invention provides ads for display as part of a web page, the Inoue advertisements are simply printed on the back of sales receipts. Dependent claim 29 highlights this distinction.

Still further, dependent Claims 10 and 12 recite particular details concerning tracking

data. More specifically, each claim explicitly identifies one of the files being combined in the

integrated ad file as including computer code, something that is neither taught nor suggested by

the data records of Inoue. Furthermore, dependent Claim 10 recites that "serving the integrated

ad file includes html code loading the integrated ad file, the html code including a tracking

identifier". Claim 10 continues by reciting "tracking the ad using code in the conduit file [which

is combined to create the integrated ad file] and the tracking identifier." Nothing in Inoue

teaches or suggests code in a file, which is combined into an integrated ad file, being used in

conjunction with a tracking identifier to track the ad being served.

Lastly, dependent Claims 20 and 21 recite, respectively, using an executable file and a

web-based application to combine the multiple files into the single integrated ad file. Inoue

failed to teach or suggest any such executable or web-based application for achieving this result.

Indeed, Inoue fails to teach or suggest creating an integrated ad file from multiple files, let alone

using the particular tools recited in the claims.

Accordingly, for the additional reasons noted above, applicants respectfully submit that

the dependent claims are further distinguishable from the art of record and are in condition for

allowance.

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CONCLUSION

Applicants thus believe that the claims in the present application are in condition for allowance. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and remarks. If the Examiner has any questions or suggestions regarding this response or the application, he is invited to contact the undersigned at the telephone number provided below.

If any extension of time is required to have this paper entered and considered, such extension is hereby petitioned. Any additional fees or charges necessary in connection with the present application are hereby authorized to be charged to Deposit Account No. 19-4709.

Respectfully submitted,

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